



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Am

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,305	11/30/2000	Thomas A. Bohannon	ALTE00012	4910
34845	7590	06/24/2005	EXAMINER	
STEUBING AND MCGUINNESS & MANARAS LLP 125 NAGOG PARK ACTON, MA 01720			KANG, PAUL H	
			ART UNIT	PAPER NUMBER

2141

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/728,305

Applicant(s)

BOHANNON ET AL.

Examiner

Paul H. Kang

Art Unit

2141

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1-4.
Claim(s) withdrawn from consideration: 5-69.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

PAUL H. KANG
PRIMARY PATENT EXAMINER

Art Unit: 2141

Continuation Sheet (PTOL-303)

Continuation of 11. does NOT place the application in condition for allowance because:

Applicants' arguments filed June 7, 2005 are NOT deemed to be persuasive. The applicants argued in substance that:

1. "The Examiner, in this application, has introduced a new ground of rejection, namely a rejection of claims 1 and 3 under 35 U.S.C. §102(e) over Rune. Previously, these claims were rejected under 35 U.S.C. §103(a). While Applicants did amend the claim in the previous [O]ffice action, [Applicants'] amendments served the effect of narrowing the claim, rather than broadening it. Thus [Applicants'] amendments could in no way necessitate a broader scope of rejection than that previously placed on the claims... Applicants understand that the Examiner has taken over handling of this application from Examiner [Yussuf], and appreciates that the Examiner did not prepare the previous action. However, in the final rejection, the Examiner has failed to respond to any of Applicant's arguments put forth in the response of 10/14/2004. Because Applicants have not [had] the ability to address the Examiner's position with regard to the previous arguments, Applicants maintain that they have not received a full and fair hearing on this application; no clear issue has been [defined] because the Applicants are unable to discern the Examiner's position with regard to their previous arguments." See Remarks, pages 17-18.

In response to point 1) above, the examiner respectfully disagrees with the applicants. The introduction of a new grounds of rejection is deemed to be proper. While it is true that applicants' amendments of 14 November 2004 narrowed the scope of certain limitations of the

pending claims, the amendments also broadened the scope of other limitations found in the claims. Specifically, the limitation “a client computer capable running a session to display or change the configuration of said network appliances” found on lines 4-5 of claim 1, was amended to “a client computer coupled to said plurality of network appliances.” In the previous grounds of rejection, the Biliris reference was relied upon to teach the limitation as originally claimed. However, applicants’ amendment to broaden the scope of this limitation, effectively removing the limitation for which Biliris was relied upon, necessitated a change in the ground of rejection. Therefore, the new grounds of rejection is proper.

The applicants further argue that because the examiner did not respond to any of applicants’ previous arguments they “have not received a full and fair hearing on this application.” The examiner disagrees. The applicants, in their wholesale amendment of the claim language, necessitated a new grounds of rejection. Applicants’ amendments significantly changed the scope of the claimed invention. Thus, the new ground of rejection not only served to remove Biliris, but also served to remap the newly amended claim language to Rune. For instance, a passage of Rune previously not relied upon was cited for the newly added limitation “in response to a connection request by the client to a mirrored network site.” See Rune, col. 6, lines 1-58. Applicants’ previous arguments of 14 November 2004 failed to discuss this newly cited passage, and accordingly the Rune reference as newly relied upon. Therefore, applicants’ previous arguments were properly deemed to be moot in view of the new grounds of rejection.

However, in an attempt to clarify the issues for appeal, the examiner fully addresses below applicants’ newly raised arguments of June 7, 2005.

2. “Rune describes a method and Internet system that attempts to improve response times by automatically selecting for use a server located relatively close to a requesting host... Claim 1, in contrast, describes a system wherein a client selects a web site based on the optimal response time of a response to a client request to the web site. The present invention overcomes problems that are inherent in the systems of Rune, which are numerous and described on page 3 of Applicant’s specification, and include that fact that web site assignment systems such as [Rune’s] do not incorporate factors including the availability and loading of the web site.” See Remarks, page 19.

As to point 2), the examiner respectfully disagrees. The applicants argue in substance that the “optimal response time” as claimed necessitates incorporation of factors including the availability and loading of the web site. Further, applicants allege that this meaning is somehow distinguishable from the teaching of Rune; specifically that “to connect to a mirrored network sites having an optimal response time” is distinguishable from connecting to “the closest server or the most appropriate server form a plurality of servers.” Claim 1, line 8 and Rune, Abstract.

The applicants are reminded that during examination, the claims are given the broadest reasonable interpretation consistent with the specification and the prior art. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The rationale for such interpretation is to reduce the possibility that the claims, once issued, are interpreted more broadly than justified, since applicant always has the opportunity to amend the claims during prosecution. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process

comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. §101 and §102. In the 35 U.S.C. §102 rejection, the examiner explained that the claim was anticipated by a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Here, when given the broadest reasonable interpretation consistent with the specification, "optimal response time" is no more than selecting from among a plurality of servers "the most appropriate server" as taught by Rune. Applicants' suggestion that "optimal response time" requires incorporation of factors including the availability and loading of the web site impermissibly reads limitations from the specification into the claims. Accordingly, applicants' arguments regarding "optimal response time" are not given weight as to the patentability of the claimed subject matter.

3. “There are several differences between Rune and the claimed invention. For example, in contrast to ‘...in response to a connection request by the client to a mirrored network site, *each network appliance* associated with each mirrored network site *responds to the connection request* to allow the client to connect to a mirrored network sites having an...optimal response time to said connection request...’ as recited in claim 1, Rune selects a site based on a hop count associated with IP addresses, the hop count being received from a neighboring router...Note a fundamental difference between the claimed invention and Rune; while a ‘host’ in Rune obtains information that is used in selecting a mirrored site from the closest router, in the claimed invention the ‘client’ receives responses ‘from each mirrored site.’ In Rune, the information stored in the routing table (hop count) does not reflect actual usage of resources at each of the mirrored sites.” Remarks, page 22 (emphasis original).

As to point 3), applicants’ characterization of Rune is incomplete. While it is true that Rune selects a site based on a hop count, Rune also teaches a system and method for “automatically selecting for use a server” wherein “in response to the second request, the router 105a determines the hop count for each IP address 116...and selects [based on the hop count] the closest alternative server...” See Rune, col. 6, lines 1-22. In Rune, the client (requesting host 152a) requests for connection to the closest alternative server or mirror server (the first and second requests). In response to this request, the network appliances, the routers, respond to enable connection to the closest server (by providing the hop count).

Additionally, as previously discussed, the claims are given their broadest reasonable interpretation consistent with the specification during prosecution. In the field of computer

networks, the terms clients and servers are functional descriptors, i.e. a device is a client when it receives information, and a server when it transmits information. Therefore, applicants' arguments that the "host" of Rune cannot be read as the "client" of the claimed invention, is not persuasive. The "host" of Rune transmits a request to select a server on the network relatively close or one that is relatively appropriate. In this context, the "host" is acting as the "client." As to applicants' argument that hop count does not reflect actual usage of resources, applicants again attempt to read limitations from the specification in the claim language.

4. As to Biliris, applicants cite various sections of Biliris not relied upon by the examiner and argue that "...Biliris teaches that client association with different CNSs is controlled by the load-balancing switch in front of a chosen server farm. Such an arrangement is different than that of the claimed invention." See Remarks, page 24.

As to point 4), applicants' arguments regarding Biliris are in no way related to the reason for combining Biliris and Rune. Biliris was relied upon to show communication through an authenticated protocol on top of a communications protocol. Applicants do not address whether Biliris teaches the features for which it was relied upon. Instead it appears applicants are arguing that Biliris is nonanalogous art. It has been held that a prior art reference must either be in the field of applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Rune and Biliris are in the field of applicants' endeavor of computer network

Art Unit: 2141

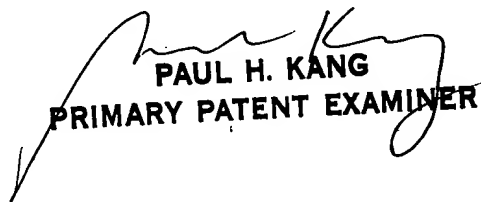
Continuation Sheet (PTOL-303)

management and data routing. Therefore, the combination of the references is proper. It is noted that Biliris need not teach any claimed limitations except for which it was relied upon. Therefore, the examiner finds applicants' arguments regarding the load-balancing scheme taught in Biliris to be unpersuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PAUL H. KANG
PRIMARY PATENT EXAMINER